UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,212	06/12/2002	Martin Bergenwall	60282.00438	9398

32294 7590 01/17/2008
SQUIRE, SANDERS & DEMPSEY L.L.P.
14TH FLOOR
8000 TOWERS CRESCENT
TYSONS CORNER, VA 22182

EXAMINER	
MATTIS, JASON E	

ART UNIT	PAPER NUMBER
2616	

MAIL DATE	DELIVERY MODE
01/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/070,212	BERGENWALL ET AL.	
	Examiner	Art Unit	
	Jason E. Mattis	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11/1/07*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16,18-20,22 and 23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16, 18-20, 22, and 23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the Amendment filed 11/1/07. Due to the amendment, the previous rejection of claim 9 under 35 U.S.C. 112 has been withdrawn. New claim 23 has been added. Claims 1-16, 18-20, 22, and 23 are currently pending in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6-9, 11-14, 16, 18, 19, 22, and 23 rejected under 35 U.S.C. 102(e) as being anticipated by Dispensa et al. (U.S. Pat. 6636501 B1).

With respect to claims 1, 11, and 16, Dispensa et al. discloses an apparatus in a system **(See column 5 lines 50-61 and Figure 2 of Dispensa et al. for reference to a module 23, which is an apparatus in a system)**. Dispensa et al. also discloses a storing unit configured to store a pre-defined list of rules for detecting packets and a detecting unit configured to detect special data packets in a received plurality of data

packets based on the pre-defined list of rules **(See column 8 lines 33-43 and Figure 6 of Dispensa et al. for reference to module 23 having a unit to store rules and a unit to use the stored rules to detect packets in step 61)**. Dispensa et al. further discloses a routing unit configured to request instructions for the special data packets detected and route the special data packets in accordance with instructions received on request **(See column 8 line 33 to column 9 line 2 and Figure 6 of Dispensa et al. for reference to module 23 requesting instructions in steps 62 and 65 and for reference to module 23 routing packets in accordance with received instructions in steps 64, 69, and 71)**. Dispensa et al. also discloses an internal entity configured to store instructions for the special data packets wherein the routing unit is configured to notify the internal entity of detected special packets and request instructions **(See column 6 lines 42-56, column 8 lines 33-43, and Figure 6 of Dispensa et al. for reference to the module 23 having a cache memory, which is an internal entity, storing instructions for routing data packets and receiving request for instructions in step 62)**. Dispensa et al. further discloses an external entity configured to determine and update the instructions stored in the internal entity during active operations **(See column 5 line 62 to column 6 line 7, column 8 lines 57-63, and Figures 2 and 6 of Dispensa et al. for reference to main router module 22, which is an entity external to module 23, determining routing instructions and updating the cache of module 23 in step 68 during active operations)**.

With respect to claims 6 and 22, Dispensa et al. discloses a method performed by a computer program implemented on a computer readable medium **(See the**

abstract and column 7 lines 5-15 of Dispensa et al. for reference to a routing method performed by software implemented on a microprocessor). Dispensa et al. also discloses storing a pre-defined list of rules for detecting special data packets and detecting special data packets in a received plurality of data packets based on the rules **(See column 8 lines 33-43 and Figure 6 of Dispensa et al. for reference to module 23 storing rules and using the stored rules to detect packets in step 61)**. Dispensa et al. further discloses requesting instructions for the detected special data packets and routing the packets in a data network in accordance with instructions received **(See column 8 line 33 to column 9 line 2 and Figure 6 of Dispensa et al. for reference to module 23 requesting instructions in steps 62 and 65 and for reference to module 23 routing packets in accordance with received instructions in steps 64, 69, and 71)**. Dispensa et al. also discloses notifying an internal entity of the detected special data packets and requesting instructions for the packets from the internal entity **(See column 6 lines 42-56, column 8 lines 33-43, and Figure 6 of Dispensa et al. for reference to the module 23 having a cache memory, which is an internal entity, storing instructions for routing data packets and receiving request for instructions in step 62)**. Dispensa et al. further discloses an external entity determining and updating the instructions stored in the internal entity during active operations **(See column 5 line 62 to column 6 line 7, column 8 lines 57-63, and Figures 2 and 6 of Dispensa et al. for reference to main router module 22, which is an entity external to module 23, determining routing instructions and updating the cache of module 23 in step 68 during active operations)**.

With respect to claims 18 and 23, Dispensa et al. discloses a network element **(See column 5 lines 50-61 and Figure 2 of Dispensa et al. for reference to a module 23, which is a network element)**. Dispensa et al. also discloses a routing unit configured to request instructions for special data packets detected by a detecting unit and route the special data packets in accordance with instructions received on request **(See column 8 line 33 to column 9 line 2 and Figure 6 of Dispensa et al. for reference to module 23 requesting instructions in steps 62 and 65 and for reference to module 23 routing packets in accordance with received instructions in steps 64, 69, and 71)**. Dispensa et al. also discloses the routing unit is configured to notify an internal entity of detected special packets and request instructions for the packets from the internal entity **(See column 6 lines 42-56, column 8 lines 33-43, and Figure 6 of Dispensa et al. for reference to the module 23 having a cache memory, which is an internal entity, storing instructions for routing data packets and receiving request for instructions in step 62)**. Dispensa et al. further discloses the routing unit notifying an external entity of detected packets and requesting instructions from the external entity instead of the internal entity **(See column 5 line 62 to column 6 line 7, column 8 lines 51-56, and Figures 2 and 6 of Dispensa et al. for reference to main router module 22, which is an entity external to module 23, receiving a request for instructions from module 23 in step 65)**.

With respect to claims 2, 7, and 12, Dispensa et al. discloses the routing unit notifying the external entity of detected packets and requesting instructions from the external entity instead of the internal entity **(See column 5 line 62 to column 6 line 7,**

column 8 lines 51-56, and Figures 2 and 6 of Dispensa et al. for reference to main router module 22, which is an entity external to module 23, receiving a request for instructions from module 23 in step 65).

With respect to claims 3, 8, and 13, Dispensa et al. discloses the external entity determining and updating the rules stored in the internal entity during active operations **(See column 5 line 62 to column 6 line 7, column 8 lines 57-63, and Figures 2 and 6 of Dispensa et al. for reference to main router module 22, which is an entity external to module 23, determining routing rules and updating the rules of module 23 in step 68 during active operations).**

With respect to claims 4, 9, 14, and 19, Dispensa et al. discloses modifying the special data packets in accordance with received instructions **(See column 8 lines 44-50 and Figure 6 of Dispensa et al. for reference to adding an adapter number and a port number to a data packet according to received instructions).**

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 5, 10, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dispensa et al. in view of Mori (U.S. Pat. 5751799).

With respect to claims 5, 10, 15, and 20, Dispensa does not disclose an external charging entity.

With respect to claims 5, 10, 15, and 20, Mori, in the field of communications, discloses using an external charging entity **(See column 23 lines 13-20 and Figure 23 of Mori for reference to a packet routing network including a charging function unit 90B, which is an external charging entity)**. Using an external charging entity has the advantage of allowing customers to be charged for network usage.
It would have been obvious for one of ordinary skill in the art at the time of the invention, when presented with the work of Mori, to combine using an external charging entity, as suggested by Mori, with the system and method of Dispensa et al., with the motivation being to allow customers to be charged for network usage.

Response to Arguments

6. Applicant's arguments filed 11/1/07 have been fully considered but they are not persuasive.

Regarding Applicant's argument that Dispensa et al. does not disclose the claimed storing unit and detecting unit, the Examiner respectfully disagrees. Dispensa et al. discloses a module 23 that uses stored rules to determine the type of a packet that has been received (See column 8 lines 33-44 and Figure 6 of Dispensa et al. for

reference to using rules, which are stored by the module 23, to determine whether a frame is of a type having a special header or not having a special header). The frames which are determined by the module 23 to not currently include a special header correspond to the claimed special data packets. The rules used by the module 23 to determine that a frame does not currently include a special header correspond to the claimed stored pre-defined set of rules for detecting special data packets. Thus Dispensa et al. does disclose the claimed storing unit and detecting unit.

Regarding Applicant's argument that Dispensa et al. does not disclose the claimed internal entity and external entity, the Examiner respectfully disagrees. Applicant argues that the external entity in claim 1 is contacted when a packet is recognized based on the pre-defined rules; however no such limitation is found in claim 1. It is the internal entity of claim 1 that is notified when a special packet has been detected by the detecting unit, not the external entity, as argued. Thus this argument is moot. Applicant also argues that the claimed external entity updates the information of the internal entity at times when the corresponding elements of Dispensa et al. does not; however, there is no limitation in the claims regarding when the external entity updates the instructions of the internal entity beyond that it happens during active operations. Since the main router module 22 of Dispensa et al. does update the cache of module 23 during active operations, Dispensa et al. does disclose the claimed external entity updating the instructions stored in the internal entity during active operations. Applicant further argues that Dispensa et al. does not disclose packets handled within a router being modified; however, there is no such limitation in the

current claims, thus this argument is moot. It is also noted that Dispensa et al. does disclose modifying the packets detected to not have a special header by adding special header including an adapter number and a port number.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason E. Mattis whose telephone number is (571) 272-3154. The examiner can normally be reached on M-F 8AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jem

HUY D. VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600